

Notice of Allowability

Application No.

09/730,559

Examiner

Joseph T. Weitach

Applicant(s)

ISHIWATA ET AL.

Art Unit

1632

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address--

All claims being allowable, PROSECUTION ON THE MERITS IS (OR REMAINS) CLOSED in this application. If not included herewith (or previously mailed), a Notice of Allowance (PTOL-85) or other appropriate communication will be mailed in due course. **THIS NOTICE OF ALLOWABILITY IS NOT A GRANT OF PATENT RIGHTS.** This application is subject to withdrawal from issue at the initiative of the Office or upon petition by the applicant. See 37 CFR 1.313 and MPEP 1308.

1. ☒ This communication is responsive to the after final mailed January 13, 2005.
2. ☒ The allowed claim(s) is/are 1,3,4,6,10-13,22 and 23.
3. ☒ The drawings filed on 07 December 2000 are accepted by the Examiner.
4. ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
 - a) ☒ All b) ☐ Some* c) ☐ None of the:
 1. ☒ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

* Certified copies not received: _____.

Applicant has THREE MONTHS FROM THE "MAILING DATE" of this communication to file a reply complying with the requirements noted below. Failure to timely comply will result in ABANDONMENT of this application.

THIS THREE-MONTH PERIOD IS NOT EXTENDABLE.

5. ☐ A SUBSTITUTE OATH OR DECLARATION must be submitted. Note the attached EXAMINER'S AMENDMENT or NOTICE OF INFORMAL PATENT APPLICATION (PTO-152) which gives reason(s) why the oath or declaration is deficient.
 6. ☐ CORRECTED DRAWINGS (as "replacement sheets") must be submitted.
 - (a) ☐ including changes required by the Notice of Draftsperson's Patent Drawing Review (PTO-948) attached
 - 1) ☐ hereto or 2) ☐ to Paper No./Mail Date _____.
 - (b) ☐ including changes required by the attached Examiner's Amendment / Comment or in the Office action of Paper No./Mail Date _____.
- Identifying indicia such as the application number (see 37 CFR 1.84(c)) should be written on the drawings in the front (not the back) of each sheet. Replacement sheet(s) should be labeled as such in the header according to 37 CFR 1.121(d).
7. ☐ DEPOSIT OF and/or INFORMATION about the deposit of BIOLOGICAL MATERIAL must be submitted. Note the attached Examiner's comment regarding REQUIREMENT FOR THE DEPOSIT OF BIOLOGICAL MATERIAL.

Attachment(s)

1. ☐ Notice of References Cited (PTO-892)
2. ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3. ☒ Information Disclosure Statements (PTO-1449 or PTO/SB/08),
Paper No./Mail Date 7/7/03
4. ☐ Examiner's Comment Regarding Requirement for Deposit
of Biological Material
5. ☐ Notice of Informal Patent Application (PTO-152)
6. ☐ Interview Summary (PTO-413),
Paper No./Mail Date _____.
7. ☒ Examiner's Amendment/Comment
8. ☒ Examiner's Statement of Reasons for Allowance
9. ☐ Other _____.

DETAILED ACTION

This application, filed December 7, 2000, is a continuation in part of application 09/090,672, filed June 4, 1998, which is a continuation in part of PCT/JP97/04468, filed December 5, 1997.

Applicants after final amendment filed January 13, 2005, has been received and entered. Claims 2, 5, 7-9, 14-21 have been canceled. Claim 23 has been added. Claim 1, 3, 4, 6, 10, 13, 22 and 23 have been amended. Claims 1, 3, 4, 6, 10-13, 22 and 23 are pending.

Election/Restriction

Applicant's election with traverse of Group VII, made on January 20, 2004 was acknowledged. Newly added claim 23 is drawn to a specific SEQ ID NO that was previously considered (see claim 3 prior to amendment and Applicants remarks, page 5).

Claims 1, 3, 10-13 and 23 are directed to an allowable product. Pursuant to the procedures set forth in the Official Gazette notice dated March 26, 1996 (1184 O.G. 86), claims 4, 6 and 22, directed to the process of making or using the patentable product, previously withdrawn from consideration as a result of a restriction requirement, are now subject to being rejoined. Claims 4, 6 and 22 are hereby rejoined and fully examined for patentability under 37 CFR 1.104.

Since all claims previously withdrawn from consideration under 37 CFR 1.142 have been rejoined, the restriction requirement made in the Office action mailed on December 18, 2003 is hereby withdrawn.

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Claims 1, 3, 4, 6, 10-13, 22 and 23 are pending and currently under examination..

Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

Priority

Receipt was acknowledged of papers submitted under 35 U.S.C. 119(a)-(d), which papers have been placed of record in the file. Acknowledgment is made of applicant's claim for foreign priority based on an application filed in Japan on December 5, 1996. It was indicated that Applicant has not complied with one or more conditions for receiving the benefit of an earlier filing date under 35 U.S.C. 120 because later-filed application must be an application for a patent for an invention which is also disclosed in the prior application (the parent or original nonprovisional application or provisional application); the disclosure of the invention in the parent application and in the later-filed application must be sufficient to comply with the requirements of the first paragraph of 35 U.S.C. 112. See *Transco Products, Inc. v. Performance Contracting, Inc.*, 38 F.3d 551, 32 USPQ2d 1077 (Fed. Cir. 1994). Specifically, the present application is a CIP of 09/090,672 and a comparison of the disclosures indicates that the present disclosure is the first presentation of the specific sequence set forth as SEQ ID NO: 7 (compare

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for example '672 Table 2, page 59 with Table 2, page 75 in the instant application). It is noted that clones designated as INM063-7 was presented, however this does not provide the specific support for SEQ ID NO: 7 currently under examination. Accordingly, the claims presently under examination are given the priority date as of the filing date of the instant application.

Applicants have not addressed the arguments or provided evidence regarding the claim for priority as it encompasses SEQ ID NO: 7 as discussed above. Accordingly, the instant application and the claims presently under examination have been given the priority date of as of the filing date of the instant application.

Reasons for Allowance

The following is an examiner's statement of reasons for allowance:

The amendments to the claims have addressed the basis of the rejection made under 35 USC 112, second paragraph, and has differentiated the claimed invention from that disclosed in Rouault *et al.*, by Genbank entry M58511, and in Samaniego *et al.* Specifically, deleting the term "represented by" and substituting the term "of" has rendered the claim clear and definite. Each of the claims would be interpreted to encompass the specific sequences set forth in the respective SEQ ID NO. Applicants have argued that the term was not indefinite nor relative, however it is noted that the art rejections were made in a manner consistent with the definitions provided for "represent" such as 'example' or 'specimen' (see Applicants remarks, page 5). With respect to the art rejections made under 35 USC 102, the amendment to the claims has changed the interpretation of the breadth now to encompass the sequences of the respective SEQ ID NOS, and not any sequence that is representative of the SEQ ID NO.

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In addition, it is noted that claims 4, 6 and 22, directed to the process of using the patentable product, previously withdrawn from consideration as a result of a restriction requirement, have been rejoined. Beyond the fact that each of the claimed methods use a product free of the art, it is noted that the present disclosure provides clear guidance and evidence that the claimed sequences can be used in methods of detection, inhibition and diagnosis as claimed (see for example introduction discussing IgA nephropathy or working Example 2).

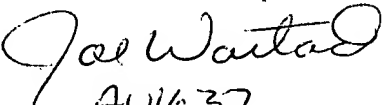
Any comments considered necessary by applicant must be submitted no later than the payment of the issue fee and, to avoid processing delays, should preferably accompany the issue fee. Such submissions should be clearly labeled "Comments on Statement of Reasons for Allowance."

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Joseph Woitach whose telephone number is (571) 272-0739.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ram Shukla, can be reached at (571) 272-0735.

Any inquiry of a general nature or relating to the status of this application should be directed to the Group analyst Dianiece Jacobs whose telephone number is (571) 272-0532.

Joseph T. Woitach


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